



23 FEB 2000

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|   |   |                |
|---|---|----------------|
| In re Application of                        | : |                |
| FREISHTAT et al                             | : | DECISION ON    |
| Application No.: 09/308,436                 | : |                |
| PCT No.: PCT/US97/20986                     | : | PETITION UNDER |
| International Filing Date: 17 November 1997 | : |                |
| Priority Date: 18 November 1996             | : | 37 CFR 1.47(b) |
| For: SYSTEM FOR INTEGRATED                  | : |                |
| MANAGEMENT OF MESSAGING AND                 | : |                |
| COMMUNICATIONS                              | : |                |

This decision is in response the PETITION UNDER 37 C.F.R. §1.47(b) filed 20 December 1999.

BACKGROUND

On 17 November 1997, applicants filed international application, PCT/US97/20986, claiming priority of provisional application 60/031,301, filed 18 November 1996. A Demand for international preliminary examination, in which the United States was elected, was filed 08 June 1998. Accordingly, the thirty month time period for paying the basic national fee in the United States in accordance with 37 C.F.R. 1.495(b), expired midnight on 18 May 1999.

On 18 May 1999, applicants filed a Transmittal Letter requesting entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee, and a "Combined Declaration and Power of Attorney".

On 18 June 1999, the United States Patent and Trademark Office (PTO) mailed applicants a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371", (PCT/DO/EO/905) and a "NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION" (PCT/DO/EO/917) which indicated that the Declaration was not properly executed, and set a one month time period for response.

On 20 December 1999 applicants filed a "Response to Notification of Missing Requirements Under 35 U.S.C. 371 and Notification of a Defective Oath or Declaration Including Petition Under 37 CFR 1.47(b)". This submission included the requisite surcharge for filing the declaration later than 30 months from the priority date; a Petition and fee for a five month extension of time; a Petition under 37 CFR 1.47(b) and requisite fee; a "Combined Declaration and Power of Attorney" by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors; Statement of authorization and proprietary interest; Supporting Declarations by Karen D. Stark and Nora M. Tocups; and other supporting documentation.

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after a diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Applicants have satisfied items (1),(3),(4),(5), and (6) above.

Regarding item (2) above, note that the petition fails to designate for each of the nonsigning inventors whether the offered proofs are for demonstrating that the nonsigning inventor is "unavailable" to sign, or if the offered proofs are for demonstrating a "refusal" to sign by the nonsigning inventor. In regard to inventors SMITH and COWDEN, the submitted evidence appears to imply their unavailability to sign based on an inability to find or reach them after diligent effort. The submitted documentation constitutes adequate proof of such unavailability. However, if "unavailability" is not the intended showing, clarification is required.

In regard to inventors LEITESS and FREISHTAT, it is not clear from the submitted evidence whether showings of "unavailability" or "refusal" are intended. Clarification on the intended showings is required. However, the submitted documentation does not adequately demonstrate either the "unavailability" of or "refusal" by either LEITESS or FREISHTAT.

On the third page of the Declaration of Karen D. Stark, she describes an October 21, 1999 telephone conversation with LEITESS: "Mr. Leiteess confirmed he had received the package and told me he would put the signed Declaration in the pre-paid envelope and mail the document the next day.". As a result, a follow-up package, such as those sent to SMITH and COWDEN, was not sent to LEITESS. This telephone conversation appears to indicate that LEITESS was not only available, but agreed to sign the declaration. While the Declaration of Karen D. Stark goes on to state that no executed declaration was received from LEITESS, some follow-up communication with LEITESS would be required to demonstrate due diligence in an attempt to have him execute the declaration, particularly given his expression of a willingness to do so. Neither the unavailability of LEITESS nor any refusal of LEITESS to execute the declaration has been adequately shown.

Based upon the Declarations of Karen D. Stark and Nora M. Tocups, it appears that an oversight was made in regards to obtaining execution of a declaration by FREISHTAT. A previously filed declaration was executed by FREISHTAT on 29 July 1998. This declaration was defective because it did not include the third page which contained the signature block for SMITH. While preparing a petition under 37 CFR 1.47(a), the defect in the previously executed declaration was discovered. On 23 November 1999, a package was prepared and sent to FREISHTAT for his execution. Apparently no executed declaration was received from FREISHTAT.

Neither the unavailability of FREISHTAT nor any refusal of FREISHTAT to execute the declaration has been adequately shown. Due to the apparent oversight, no declaration for execution was sent to FREISHTAT until 23 November 1999, less than a month prior to the filing of the present petition on 20 December 1999. A lack of response from FREISHTAT in such a short time period, along with the lack of any alternative or follow-up attempts to contact FREISHTAT, does not adequately demonstrate any unavailability or refusal on the part of FREISHTAT. Further, his execution of the original, defective declaration appears to indicate his willingness to do so. Note that the apparent oversight and delayed attempt to contact FREISHTAT also brings into question whether a diligent effort was made to obtain the signature of FREISHTAT.

As a further matter, note that on page two of the "Combined Declaration and Power of Attorney" the post office address for FREISHTAT is listed as 2078 Renfro Lake Drive, Dunwoody Georgia, while the 23 November 1999 package was sent to 2078 Renfro Lake Drive, Atlanta Georgia. This inconsistency requires explanation. Further still, note that on page two of the "Combined Declaration and Power of Attorney" the PCT Filing Date is incorrectly listed as "11 November 1996" instead of the actual filing date of 17 November 1997.

CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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